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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/829,367 | 04/09/2001 | William Wai Lun Yip | TONG-YIP-101 | 9683 |
| 7590 | 09/23/2004 | | EXAMINER | |
| Robert K. Tendler 65 Atlantic Avenue Boston, MA 02110 | | | SON, LINH L D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2135 | |

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/829,367 | LUN YIP, WILLIAM WAI | |
| | Examiner | Art Unit | |
| | Linh Son | 2135 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/09/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 8-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu, US Patent No. 2002/0082986A1, hereinafter '986, in view of Griffith, US Patent No. 6195542B1, hereinafter '542.

As per claims 1 and 8, "A system for securely authorizing a disbursement transaction from a financial institution which has funds under the control of an individual, comprising a financial institution adapted to disburse funds upon authorization of an individual to a vendor" is taught in '986 (Para 0024, and 0044-46); "a terminal at said vendor for initiating a disbursement transaction and for transmitting to said financial institution the amount of said disbursement the identity of said terminal" is taught in '986 (Para 0048, and 0049); "a communication channel from said financial institution to said terminal for transmitting a transaction identification to said terminal" is taught in '986 (Para 0044, and 0050); "a display at said terminal for displaying said transaction identification" is

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taught in '986 (Para 0050, 0053) ; and "a wireless transmitter in the possession of said individual for transmitting a predetermined code identifying said individual and said displayed transaction identification number to said financial institution, the receipt of which by said financial institution causing authorization of disbursement of said amount" is taught in '986 (Para 0051-0055). However, the transaction identification number is not clearly explained in '986. Nevertheless, the transaction number is implemented in '542 as a reference number to the transaction (Col 5 lines 43-65). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modified the invention in '986 to implement the transaction number in '986 to speed up the confirmation process of the transaction.

As per claim 2, "The system of claim 1, wherein said predetermined code is a personal identification number" is taught in '986 (Para 0059).

As per claim 9, Claim 1 is incorporated. Further "The method of claim 8, wherein the transaction identification number is unique to the transaction and changes from one transaction to the next" is taught in '542 (Col 4 lines 19-40).

As per claim 10, "The method of claim 8, wherein the step of transmitting includes transmitting a predetermined code identifying the individual authorizing the disbursement" is taught in '986 (Para 0024).

As per claim 13, claim 1 is incorporated. Further, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize that the location of the transmitter is at when entering the information for the transaction need not to be near the transaction vendor terminal since it is a portable wireless device.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu, US Patent No. 2002/0082986A1, hereinafter '986, in view of Griffith, US Patent No. 6195542B1, hereinafter '542.

As per claim 3, "The system of claim 1, wherein said predetermined code is the electronic serial number of said wireless transmitter" is not clearly taught in '986. Nevertheless, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to incorporate the serial number of the wireless transmitter as the predetermined code or transaction code so that the identity of the wireless device can also be verified because of its uniqueness.

4. Claims 4-7, 11-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu, US Patent No. 2002/0082986A1, hereinafter '986, in view of Griffith, US Patent No. 6195542B1, hereinafter '542, and further in view of Maes et al, US Patent NO. 6016476, hereinafter '476.

5. As per claims 4 and 12, "The system of claim 1, wherein said wireless transmitter includes a selector for selecting which financial institution is the one from which said disbursement is to be made, said wireless transmitter transmitting said selected financial institution identification to the selected financial institution" is not taught in either '986 or '542. Nevertheless, the invention in '476 teaches a method and system to make a transaction with a vendor utilizing a wireless device. The method of processing the transaction is not carried out similar to the claimed invention, but the result is the same. Further, the invention allows the user to select the financial institution to fund the transaction (Col 4 lines 1-5, and Col 7 lines 3-12). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to incorporate the teaching in '476 with '542's to allow the purchaser to have the flexibility to carry out any type of transaction.

6. As per claim 5, the invention in '986 is clearly explain that the system include the transaction identification center, also can be a financial organization, that issues a customer code and a transaction code to a register customer (Para 0025). However '986 does display the selection of the financial institute at the time of the transaction.

Nevertheless, it would have been obvious at the time of the invention for one having ordinary skill in the art to modify the invention to utilize a plurality of financial institutions to make the purchase and each of the financial institution would have its own predetermined code to have the flexibility of making the purchase and at the same time would prevent unauthorized transaction using the compromised pass-code to other financial institutions.

7. As per claims 6 and 11, "The said predetermined code is entered into said wireless transmitter and is transmitted to said financial institution prior to the individual arriving at said terminal, whereby the entry of said predetermined code can be made in secret" is taught in '986 (Para 0024).

8. As per claims 7 and 14, claim 6 is incorporated. However "The system of claims 6 and 8, and further including a transaction timeout and wherein said authorization from said wireless transmitter must arrive before said timeout to authorize said disbursement" is not clearly explained in '986. Nevertheless, in '542 the invention is clearly explained the timeout mechanism to ensure a legitimate transaction (Col 5 lines 43-50). Therefore, it would have been obvious at the time of the invention for one having ordinary skill in the art to incorporate the timeout mechanism to authorize the disbursement in order to ensure the integrity of the transaction.

Conclusion

9. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (703)-305-8914.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (703)-305-4393. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-9600.

11. Please notice. Due to the Office moving, the telephone numbers above will only be valid until October 15th of 2004. After that, the follow list of numbers will be valid:

Examiner: (571) 272-3856.

Kim Y. Vu: (571) 272-3859

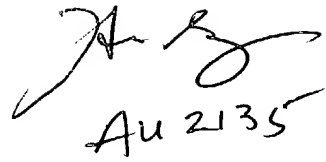
Receptionist: (571) 272-2100

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIR.I system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pzt-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Linh LD Son

Patent Examiner

Handwritten signature and text "Au 2135" in black ink.